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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/762,311	06/25/2001	Marta Blumenfeld	46.US2.PCT	2795

27206 7590 09/20/2002

GENSET  
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SAN DIEGO, CA 92121

EXAMINER

DAVIS, NATALIE A

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 09/20/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/762,311

Applicant(s)

BLUMENFELD ET AL.

Examiner

Natalie A. Davis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 7-2-02.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 42-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 42-63 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

*Election/Restrictions*

**DETAILED ACTION**

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 42-57 and 59, drawn to a composition comprising nucleotide sequences of TBC-1 and a method of making a polypeptide.

Group II, claim(s) 58, drawn to a composition comprising a TBC-1 antibody.

Group III, claim(s) 60-63, drawn to a method of genotyping by determining the identity of a polymorphic base at a TBC-1-related biallelic marker.

2. The inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Inventions I-III have been found by the examiner to have no special technical feature that defined a contribution over the prior art because Zon, et al., (U.S. Patent 5,700,927, 1997) teach the TBC1 gene and uses thereof. Since the inventions do not contribute a special technical feature when viewed over the prior art, they do not have a single inventive concept and lack unity of invention.

3. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

A- biallelic marker in position 9494 of SEQ ID NO: 1

B- biallelic marker in position 1443 of SEQ ID NO: 2

C- biallelic marker in position 5247 of SEQ ID NO: 2

D- biallelic marker in position 6223 of SEQ ID NO: 2  
E- biallelic marker in position 14723 of SEQ ID NO: 2  
F- biallelic marker in position 19186 of SEQ ID NO: 2  
G- biallelic marker in position 18997 of SEQ ID NO: 2  
H- biallelic marker in position 19891 of SEQ ID NO: 2  
I- biallelic marker in position 29617 of SEQ ID NO: 2  
J- biallelic marker in position 42519 of SEQ ID NO: 2  
K- biallelic marker in position 69324 of SEQ ID NO: 2  
L- biallelic marker in position 69181 of SEQ ID NO: 2  
M- biallelic marker in position 69146 of SEQ ID NO: 2  
N- biallelic marker in position 76458 of SEQ ID NO: 2  
O- biallelic marker in position 78595 of SEQ ID NO: 2  
P- biallelic marker in position 82159 of SEQ ID NO: 2  
Q- biallelic marker in position 84522 of SEQ ID NO: 2  
R- biallelic marker in position 84810 of SEQ ID NO: 2  
S- biallelic marker in position 89967 of SEQ ID NO: 2

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

In the event applicant elects claim(s) 42-57 and 59 of Group I or Claim(s) 60-3-63 of Group II, applicant is required to elect a single species of biallelic marker.

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4. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons:

According to PCT Rule 13.2 and to the guidelines in Section (f) (i) (B) (1) of Annex B of the PCT Administrative Instructions, all alternatives of a Markush Group must have a common structure. Although the polynucleotides share a common property, a biallelic marker, the polynucleotides are not regarded as being of similar nature because all the alternatives do not share a common structure.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Davis whose telephone number is 703-308-6410. The examiner can normally be reached on M-F 8-5:30 (every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa PhD can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4315 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Natalie A. Davis, PhD  
September 18, 2002

  
SHEELA HUFF  
PRIMARY EXAMINER